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RFC

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IES Industries Inc.

Serial No. 74/638,378

James C. Nemmers for IES Industries Inc.

Andrew J. Benzmiller, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 27, 1995, applicant applied to register the mark shown below

on the Principal Register for “public utility services in the nature of supplying electrical power, steam and natural

gas; and transportation of goods by rail and barge," in Class 39; and for other services which were subsequently deleted by amendment. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services.

The application claimed ownership of Registration Nos. 1,630,353 and 886,043. These two registrations were issued in 1990 and 1991, respectively, for the same mark, the letters "IE" and a design. The former was canceled under the provisions of Section 8 of the Act in 1997, while the later apparently remains in effect. The services are identified in the subsisting registration as "public utility supplying electricity." Applicant explains in its brief that its original name was "Iowa Electric Light and Power Company," and that the letters "IE" in the previously registered marks stood for the initial letters in its prior name.

The instant application is now before the Board on appeal from the final refusal to register based on Section 2(d) of the Lanham Act. The Examining Attorney has determined that if applicant's mark were used in connection with the electric utility services set forth in the application, namely "supplying electrical power," applicant's mark would so resemble the mark "IES," which is

registered[1] for "consulting services in the field of electric energy," in Class 42, that confusion would be likely.

Based on the record before us, we agree that confusion would be likely because the marks create very similar commercial impressions and the services set forth in the application are closely related to those identified in the cited registration.

Notwithstanding applicant's argument to the contrary, when these two marks are considered in their entireties, they are quite similar. The dominant portion of applicant's mark, i.e., the part which is more likely to be noticed, remembered and used in reference to it, is plainly the literal portion of the mark, the letters "IES," and it is these very same letters that constitute the registered mark in its entirety.

The curved line design in applicant's mark does not alter our conclusion that the two marks are likely to be confused. Applicant's mark is essentially the letters "IES," and there is nothing particularly unusual or distinctive about the design or the way the letters are presented in it. The design does not add or detract much from the letters. The letters plainly dominate applicant's

[1] Reg. No. 1,760,417, issued to International Energy Services U.S.A., Inc. on March 23, 1993, based on a claim of use in commerce since July 1, 1991.

mark. See: Jaybee Mfg. Corp. v. L. E. Johnson Products, Inc., 154 USPQ 246 (TTAB 1967); and Edison Brothers Stores, Inc. v. Brutting E.B. Sport International GmbH, 230 USPQ 530 (TTAB 1986).

As the Examining Attorney points out, the issue is not whether the marks are identical or whether they might be confused if they were to be compared on a side-by-side basis. Instead, the question for us to answer is whether they create similar overall commercial impressions. If both of these two "IES" marks were to be used in connection with closely related services, confusion would be likely.

Our inquiry thus turns to the services set forth in the application and the cited registration. As noted above, the registered mark is for consulting services in the field of electric energy, and the application specifies that one of the services with which the applicant, a public utility company, intends to use its mark is supplying electrical power. These services are closely related. Applicant itself admits that it renders both consulting services relating to the efficient use of energy, on one hand, and the service of supplying electricity, on the other. Additionally, the Examining Attorney made of record third-party registrations wherein the services listed include both public energy utility services and energy consultation services. These registrations are probative of the

contention that consumers have a basis upon which to expect that the use of similar marks on both types of services indicates that they emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Even without the evidence that applicant and other electric utilities both supply power and provide consulting services with regard to its use, it is reasonable to conclude that the consultation services in the field of electrical energy which are rendered under the registered mark could involve consulting with respect to the use of the electrical power provided by a public utility such as applicant. Because of the close relationship between these activities, consumers are likely to view the use of similar marks in connection with such services as indicating that they are rendered by one entity.

Applicant's arguments that its services are limited and are not rendered to the same customers through the same trade channels as registrant's services are is not based on any evidence. Moreover, the respective recitations of services in the application and the registration do not reflect the narrower descriptions of the respective services on which applicant predicates this argument. In the absence of limitations or restrictions in the registration and the application, respectively, this argument is not persuasive. We must consider the services as they are identified in the

registration and application, without unspecified restrictions. In re Elbaum, 211 USPQ 639 (TTAB 1981). When we take this approach, as noted above, we find the services to be closely related.

To whatever extent applicant's arguments could be interpreted as contending that confusion would not be likely because its customers are familiar with its previously registered marks consisting of the letters "IE" and a design, we note for the record that this position is not supported by either evidence or logic. The logical extension of this argument is that customers will not be confused no matter how similar applicant's mark is to the cited registered mark because applicant's customers know with whom they are dealing. However, we must determine whether applicant's mark is likely to cause confusion with the previously registered mark, not whether the mark will be ignored.

In summary, confusion would be likely if applicant were to use its "IES" and design mark in connection with its electric utility service of supplying electricity in view of the registered mark "IES" for consulting services in the field of electric energy. The marks, when considered in their entireties, create similar commercial impressions, and the services are closely related. Accordingly, the refusal to register under Section 2(d) of the Act is affirmed and registration to applicant is refused.

R. F. Cissel

E. J. Seeherman

E. W. Hanak
Administrative Trademark Judges,
Trademark Trial & Appeal Board